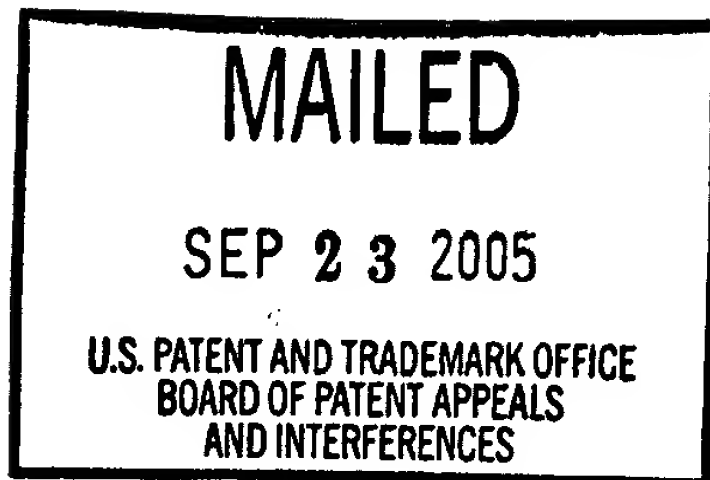


The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARRETT RICHARD BOBSEIN,
WILLIAM CHRISTOPHER FINCH,
and
DAVID ALBERT GLEESON



Appeal No. 2005-1332
Application No. 09/774,064

ON BRIEF

Before PAK, WARREN, and TIMM, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1 and 3 which are all the claims pending in the application.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

Claims 1 and 3 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Japanese Published Unexamined Application 05-170,802 to Hoshino et al. published on July 9, 1993 (Hoshino).¹

The claims stand or fall together (Brief, p. 4). We select claim 1 to represent the issues on appeal. Claim 1 reads as follows:

1. A waterborne pigmented paper or paperboard coating composition comprising pigment comprising 50% to 100%, by weight of said pigment, calcium carbonate and from 1% to 25%, as dry weight by weight of said pigment, of an aqueous polymeric dispersion comprising
 - (c) 95-25% by weight, based on the weight of the solids of said aqueous polymeric dispersion, of a first emulsion polymer having an average particle diameter of 150 to 3000 nanometers and
 - (d) 5-75% by weight, based on the weight of the solids of said aqueous polymeric dispersion, of a second emulsion polymer having an average particle diameter of 40 to 600 nanometerswherein the ratio of said average particle diameter of said first emulsion polymer to said average particle diameter of said second emulsion polymer is from 1.2 to 60, wherein at least said first emulsion polymer particles, when dry, contain at least one void, and wherein said first emulsion polymer is prepared in the presence of said second emulsion polymer or said second emulsion polymer is prepared in the presence of said first emulsion polymer.

Because the Examiner has established a prima facie case of obviousness, we affirm. Our reasons follow.

¹We rely upon and cite to the English translation made of record on March 14, 2005.

OPINION

Hoshino describes a waterborne pigmented paper or paperboard coating composition including, among other things, a pigment containing inorganic pigments and emulsion particles as plastic pigments (Hoshino, ¶ 0016, ll. 6-10). Hoshino notes that hard emulsion particles have been studied as additives for coating agents for reducing coating weight, improving gloss, whiteness, opacity, etc. (Hoshino, ¶ 0002, ll. 1-4). According to Hoshino, the industrial use of these emulsion particles as replacements for inorganic pigments such as kaolin, calcium carbonate, talc, satin, etc. in the paper coating field is increasing (Hoshino, ¶ 0002, ll. 4-7).

Hoshino describes emulsion particles with a bimodal particle distribution (Hoshino, ¶ 0009-10). The Examiner finds, and Appellants do not dispute, that the Examples of Hoshino show the claimed proportion and diameters of the two emulsion polymer particles required by claim 1 (Answer, p. 3; Brief and Reply Brief in their entirety). Nor is there any dispute that the emulsion polymer particles of Hoshino meet the other requirements of the aqueous polymeric dispersion recited in claim 1 (Answer, p. 3; Brief and Reply Brief in their entirety). Appellants' arguments focus instead on the calcium carbonate concentration recited in the claim. The issue, therefore, is whether Hoshino sufficiently describes including calcium carbonate in the composition in an amount sufficient to anticipate the composition of the claim or whether there is a sufficient reason, suggestion, or motivation to add calcium carbonate in the claimed amount such that there is a prima facie case of obviousness.

Anticipation

We agree with Appellants that Hoshino does not disclose each and every limitation of claim 1 with sufficient specificity such that the claimed composition is anticipated. In order to anticipate, Hoshino must clearly and unequivocally disclose the claimed invention or direct those skilled in the art to the invention without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972). “Such picking and choosing may be entirely proper in the making of a 103, obviousness rejection, where the applicant must be afforded an opportunity to rebut with objective evidence any inference of obviousness which may arise from the similarity of the subject matter which he claims to the prior art, but it has no place in the making of a 102, anticipation rejection.” *Arkley*, 455 F.2d at 587-88, 172 USPQ at 526.

The Examiner’s finding of anticipation is based upon the disclosure in Hoshino of a concentration of aqueous polymeric dispersion in the range of 3-30% as a preferred embodiment coupled with a disclosure calcium carbonate in a list of six inorganic pigments. But Hoshino, in fact, does not limit the inorganic pigments to the six compounds specifically recited. What Hoshino states is that “[s]ome examples of the inorganic pigments include kaolin, calcium carbonate, talc, satin white, titanium dioxide, etc.” Moreover, the only exemplified composition contains an inorganic pigment mixture of 63 parts of kaolin clay with 27 parts of calcium carbonate. Therefore, mixtures are also contemplated. One of ordinary skill in the art, in fact, is directed to picking and choosing an inorganic pigment from a much larger genus than

acknowledged by the Examiner. Moreover, there is no direct disclosure of a pigment mixture containing an amount of calcium carbonate within the claimed range coupled with an amount of emulsion particles in the claimed range of 1-25%. To obtain the composition of claim 1, one of ordinary skill in the art must both pick and choose among the various acceptable inorganic pigments and conduct some experimentation, albeit routine in nature, with regard to the amount of inorganic pigment and emulsion particles to include in the pigment. Therefore, we find the disclosure of Hoshino lacks the specificity required for a finding of anticipation.

Obviousness

The question of obviousness, however, stands on a different footing. As stated above, picking and choosing within the teachings of the prior art is entirely proper in the context of an obviousness rejection. *Arkley*, 455 F.2d at 587-88, 172 USPQ at 526. Routine experimentation involving such parameters as concentration is also proper in the context of obviousness. *See In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). Note also *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Claim 1 requires that calcium carbonate be present in the pigment in an amount of 50-100 weight %. The claim further requires that the aqueous dispersion of emulsion polymers be present in an amount of 1-25%, as dry weight by weight of the pigment. The Examiner finds that Hoshino describes, as a preferred embodiment, including the emulsion polymer particles in an amount of 3-30% by weight of the pigment and concludes, therefore, that the inorganic pigment

must be present in an amount of 70-97% by weight of the pigment in that preferred embodiment (Answer, p. 3). Appellants traverse this finding on the basis that “this is not the literal disclosure of Hoshino.” (Brief, p. 4). Appellants’ traversal is not persuasive because, even though Hoshino does not say it literally, the disclosure is present. The pigment of Hoshino is a combination of inorganic pigments and the emulsion particles as “plastic pigment” (Hoshino, ¶ 0016, ll. 6-9). The amount of emulsion particles is related in Hoshino as a percentage of the “entire pigments.” (Hoshino, ¶ 0017, ll. 1-4). Therefore, the percentage of inorganic pigments is the amount which is not emulsion pigment.² We, therefore, find adequate factual support in Hoshino for the finding made by the Examiner, i.e., that Hoshino describes by default including inorganic pigment in an amount of from between 97 and 70% by weight of the entire pigment in the preferred embodiment. That Hoshino includes other less preferred embodiments and examples does not, contrary to the arguments of Appellants (Brief, p. 5), somehow negate the disclosure of the preferred embodiment.

²The words “entire pigments” would be understood by one of ordinary skill in the art to be referring to the combination of emulsion particles as plastic pigments and inorganic pigments. This is the case because inorganic and plastic pigments are the only components that make up the pigment. In fact, the plastic pigments are said to be a replacement for inorganic pigments (Hoshino, ¶ 0002, ll. 4-7). Also note that Hoshino calculates the quantity of other components based on the combined amount of inorganic and plastic pigments (Hoshino, ¶ 0016, ll. 19-22). Moreover, the formulation provided on page 22 of the translation of Hoshino further validates the Examiner’s interpretation of the reference as the pigment amounts (clay, calcium carbonate and emulsion particles) add up to 100 parts by weight.

We agree with the Examiner that it would have been obvious to one of ordinary skill in the art to select calcium carbonate as the inorganic pigment in the composition of Hoshino as it is expressly suggested in the reference. It follows then that Hoshino suggests the use of a pigment containing 70-97% by weight calcium carbonate as required by claim 1.

Appellants argue that the Examiner has not met his burden in establishing a prima facie case of obviousness because he has not pointed to any disclosure within Hoshino which indicates a realization of the problem faced by Appellants or which would motivate one skilled in the art to form Appellants' composition (Brief, p. 6). This argument is not persuasive for several reasons. First, the prior art need not address Appellants' problem. *In re Dillon*, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901-1902 (Fed. Cir. 1990)(*en banc*), *cert. denied*, 500 U.S. 904 (1991). Second, Hoshino recognizes both gloss and brightness (whiteness), the properties focused on by Appellants, as important properties to be optimized (Hoshino, ¶ 0008). Third, Hoshino describes dispersions having the bimodal particle composition claimed, describes calcium carbonate as one of the inorganic pigments which can be combined with the emulsion particles and suggests amounts within and/or overlapping those of the claim. Under these circumstances, a case of prima facie obviousness is properly established. Where the difference between the claimed invention and the prior art is some range or other variable within the claims, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990).

We conclude that the Examiner has established a prima facie case of obviousness with respect to the subject matter of claims 1 and 3 which has not been sufficiently rebutted by Appellants. To the extent that Appellants are relying upon a showing of unexpected results to overcome the prima facie case of obviousness, we note that sufficiently probative objective evidence has not been relied upon in this appeal. Attorney arguments in the brief cannot take the place of evidence. *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972).

CONCLUSION

To summarize, the decision of the Examiner to reject claims 1 and 3 under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a) is affirmed on the basis of obviousness under § 103(a).

AFFIRMED

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